

PATENT

Atty Docket No.: 200312030-1
App. Scr. No.: 10/614,856

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-36 are pending in the present application, of which, Claims 1, 13, 28, and 32 are independent.

Improper Restriction Requirement**No Serious Burden Established in the Official Action**

MPEP 803 sets forth the requirements for identifying when a restriction requirement of patentably distinct inventions is proper. As stated therein, a restriction requirement between patentably distinct inventions is proper if the inventions are independent or distinct and if "there would be a serious burden on the examiner if restriction is not required. As also stated therein, "a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02."

In the instant case, regardless of whether the claims grouped in Group I and the claims grouped in Group II are considered to be independent or distinct, the Official Action has failed to *prima facie* establish that a serious burden exists because, as stated in paragraph 1 of the Official Action, Claims 1-12 and 13-36 are classified in the same class and subclass. Clearly, therefore, the assertion in paragraph 4 of the Official Action that there would be a serious burden on the examiner if the restriction is not required is improper.

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Accordingly, the Restriction requirement is clearly improper and should be withdrawn.

Claims Restricted Under an Improper Basis

The Official Action has not presented arguments that Claims 1-12 are independent from Claims 13-36. Instead, the Official Action has argued that Claims 1-12 are allegedly distinct from Claims 13-36. In setting forth this argument, however, the Official Action appears to have misconstrued to meaning of the term "distinct". As set forth in MPEP 802.01, "[r]elated inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention (novel and unobvious) is **PATENTABLE OVER THE OTHER** (though they may each be unpatentable over the prior art)".

The Official Action has asserted that Claims 1-12 (Group I), which are directed to a system for managing inventory components and Claims 13-36 (Group II), which are drawn to a system and method for managing inventory components, are somehow related as subcombinations that are usable together in a single combination. The reasons for requiring a restriction between Group I and Group II are improper because the claims of Group I and the claims of Group II cannot reasonably be construed as being subcombinations with respect to each other because one group is directed to system claims and the other group to method, means-plus-function system, and computer-readable medium claims. In fact, the undersigned has never previously seen a Restriction Requirement in which a set of system

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claims and a set of method claims were considered as being subcombinations with respect to each other.

In any regard, MPEP § 806.05(d)(B) states "restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search." Clearly, the Official Action has not established that a serious burden would exist, and the restriction is therefore improper.

Election of Species Requirement is Improper

The Official Action asserts that Claims 13-36 are also subject to an election of species requirement. More particularly, the Official Action asserts that paragraph 0005 is directed to Species A, that paragraph 0006 is directed to Species B, and that paragraph 0007 is directed to Species C. It should be noted that paragraph 0006 is a summary of independent Claim 13, paragraph 0007 is a summary of independent Claim 28, and paragraph 0008 is a summary of independent Claim 32. As such, the Official Action is requiring the Applicants to elect between a set of method claims, a set of means-plus-function claims that claim a system for performing the method claimed in the method claims, and a set of computer-readable medium claims that recites all of the same steps as claimed in the method claims.

Initially, the election of species requirement is inappropriate because method claims, means-plus-function claims, and computer-readable medium claims are typically not considered to be different species. Different species could be, for instance, two apparatuses, such as, desks having different configurations, disclosed and claimed in the same patent application.

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Secondly, the election of species requirement is inappropriate because, again, there is no serious burden on the Examiner to examine all of the claims as evidenced by the fact that Claims 13-36 have are classified in the same class and subclass with each other, as asserted in the Official Action.

For at least the foregoing reasons, the Examiner is respectfully requested to withdraw the election of species requirement.

Restriction Requirement

The aforementioned Restriction Requirement asserts that the present application contains claims that are directed to two distinct inventions. As defined in the Official Action, these inventions are:

Group I: Claims 1-12, directed to a system for managing inventory components.

Group II: Claims 13-36, directed to a system and method for managing inventory components.

A restriction requirement has been imposed requiring an election of one of the groups on the alleged basis that the above-identified groups are independent or distinct from each other. In addition, the Official Action alleges that the search required for one of the groups is not required for the other group, even though the Official Action has indicated that the claims are classified in the same class and subclass.

In response to that restriction requirement, Applicants hereby elect, with traverse, Group I, directed to Claims 1-12.

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The election is made with traverse, because it is believed that all of the claims of this application can be examined at the same time without serious burden. The search required for the non-elected group would likely be co-extensive with that required for the elected group, for at least the reasons set forth above. As such, the search required for elected Claims 1-12 will, in most likelihood, encompass a search for non-elected Claims 13-36. As stated in Section 803 of the MPEP, "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions."

It is thus submitted that no serious burden would result if all of the embodiments of this application were examined concurrently. Accordingly, withdrawal of the restriction requirement and examination of all of the claims contained in this application, are respectfully requested.

The election of species requirement is considered moot in light of the election of the claims contained in Group I.

Conclusion

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the above-identified application, please contact the undersigned at the telephone number listed below.

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Please grant any required extensions of time and charge any fees due in connection
with this request to deposit account no. 08-2025.

Respectfully submitted,

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By



Timothy B. Kang
Registration No.: 46,423MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3817
(703) 865-5150 (facsimile)